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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,105	01/08/2001	Robert L. Pitts	TI-29117	6920

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EXAMINER

FOX, BRYAN J

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/757,105	Applicant(s) PITTS, ROBERT L.	
	Examiner Bryan J Fox	Art Unit 2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 and 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 and 14-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 8 and 14, 16 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Taguchi (US006052577A).

Regarding claims 8 and 14, Taguchi discloses a portable telephone system with base stations A, B and C (see column 3, lines 5-12 and figure 1), which reads on the claimed "at least one relatively long range base station having a first relatively large coverage area," and a communication prohibiting/limiting station 2 within cell area a such that an area 10 is set as a communication limitation area 10 where use of a portable telephone 3 as a mobile station is prohibited (see column 3, lines 13-17 and figure 1), which reads on the claimed "short-range base station having a second short coverage area relative to said at least one long-range base station and disposed within the coverage area of said at least one relatively long-range base station; said short-range base station controlling all wireless mobile communications to and/or from said at least one relatively long range base station within said short coverage area, said short-range base station restricting operation of communication devices disposed within said

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short coverage area which are capable of communicating with said at least one relatively long range base station”.

Regarding claims 16 and 21, Taguchi discloses that in response to the limitation signal, the mobile station issues a notice indicating that portable telephone is positioned in use limitation area and displays that portable telephone is positioned in use limitation area (see figure 3, steps 104, 105 and 106), which reads on the claimed “means responsive to said short range base station for providing at least one predetermined function at said communication devices”.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi in view of Stein (US005771468A). Taguchi fails to disclose that controlling the wireless communications would be done in more than one format on more than one channel.

In a similar field of endeavor, Stein discloses a base station capable of communicating in a plurality of telecommunications systems where the systems operate according to different standards (see column 2, lines 28-31), which reads on the claimed "controlling communications is done in more than one format". Furthermore, since the communications are done in more than one format, they must be done in more than one channel as claimed.

It would be obvious to one skilled in the art at the time of the invention to modify the system disclosed by Taguchi to include the multi-system compatibility disclosed by Stein in order to provide compatibility with multiple systems.

6. Claims 17-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi in view of da Silva (US006496703B1).

Regarding claims 17 and 22, Taguchi fails to expressly disclose altering predetermined types of communications from said communication devices to said long range base station.

In a similar field of endeavor, Da Silva discloses a system for disabling wireless communication devices where, in the case of an emergency call, the caller would be asked if an emergency exists, and if so to press a number on the key pad and the caller could be handled by a service person or automatically and the CSP would enable the cellular phone and complete the call (see column 9, lines 33-42), which reads on the claimed "altering predetermined types of communications from said communication devices to said long range base station".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Taguchi with da Silva to include the above allowing of emergency calls in order to provide immediate assistance to the user in case of emergency.

Regarding claims 18 and 23, Taguchi fails to expressly disclose precluding audible responses.

In a similar field of endeavor, Da Silva discloses a system that keeps a record of cellular phones having vibrating announcers, rather than ringing announcers and allow these phones to operate in a zone where ringing is prohibited (see column 7, lines 38-52), which reads on the claimed "precluding audible responses at said communication devices".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Taguchi with da Silva to include the above disabling ringing while allowing vibrating alerts in order to notify the user of the incoming call without introducing interference.

Regarding claims 19 and 24, Taguchi fails to disclose a response to be converted from an audible response to a non-audible response.

In a similar field of endeavor, da Silva discloses a system that keeps a record of cellular phones having vibrating announcers, rather than ringing announcers and allow these phones to operate in a zone where ringing is prohibited (see da Silva column 7, lines 38-52), which reads on the claimed "causing a response to be converted from an audible response to a non-audible response".

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Taguchi with da Silva to include the above use of vibrating announcers instead of ringing announcers in order to avoid disruption to others.

Regarding claims 20 and 25, Taguchi fails to expressly disclose altering predetermined types of communications from said communication devices to said long range base station.

In a similar field of endeavor, da Silva discloses a system for disabling wireless communication devices where, in the case of an emergency call, the caller would be asked if an emergency exists, and if so to press a number on the key pad and the caller could be handled by a service person or automatically and the CSP would enable the cellular phone and complete the call (see da Silva column 9, lines 33-42), which reads on the claimed "altering predetermined types of communications from said communication devices to said long range base station".

Response to Arguments

7. The applicant argues in the first page, third paragraph of the remarks that Taguchi fails to disclose two base stations. The examiner respectfully disagrees. Taguchi discloses a base station A (1) and a communication prohibiting/limiting station (2), which are two base stations.

The applicant argues that Taguchi fails to disclose the limited coverage base station controls all wireless mobile communications to and/or from the at least one relatively long range or large coverage base station within the short coverage area. The examiner respectfully disagrees. Taguchi discloses that in response to the reception of

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the use limitation, communication with the base station may be prohibited (see column 2, lines 7-12), which reads on the claimed "the limited coverage base station controls all wireless mobile communications to and/or from the at least one relatively long range or large coverage base station within the short coverage area." This also reads on the restricting operation of communication devices disposed within the short coverage area.

The applicant makes similar arguments in the second page, first and second paragraphs of the remarks with respect to claim 14, however, for the same reasons above, the examiner respectfully disagrees.

The arguments with respect to claims 15-25 simply restate the claims. For the same reasons outlined in the rejection of claims 15-25, the examiner respectfully disagrees.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (703) 305-8994. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marsha D Banks-Harold

BJF

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